IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gerd GEISSLINGER et al.

Title: ***USE OF VERAPAMIL AND VERAPAMIL DERIVATIVES FOR PRODUCING MEDICAMENTS WITH AN INHIBITING EFFECT ON BETA-GLUCURONIDASE IN HUMAN TISSUE***

Appl. No.: 09/980,824

Filing Date: 12/07/2001

Examiner: B. Kwon

Art Unit: 1614

RESPONSE TO RESTRICTION REQUIREMENT

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Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed February 12, 2004, Applicant hereby provisionally elects **Group I**, claims 10, 12-6, and 19 for examination, **with traverse**.

The Examiner required restriction between two inventions on the ground that the inventions lack the same or corresponding technical feature. According to the Examiner, the inventions are represented by claims 10, 12-6, and 19 (Group I), drawn to a method of treatment, and claims 17 and 18 (Group II), drawn to a method of selectively activating a glucuronide prodrug. In the Examiner's opinion, the technical feature of Group I is the ability of verapamil or its derivatives to inhibit human tissue glucuronidase, while that of Group II is the ability of a glucuronidase inhibitor to selectively activate a glucuronide prodrug. Thus under PCT Rule 13.1, the Examiner concludes, the two groups do not share the same or

corresponding special technical feature. As noted above, Applicants respectfully **traverse** the requirement for restriction.

The restriction requirement is improper because the same inventive concept underlies both groups of claims. Specifically, all of the claims encompass the inhibition of glucuronidase by the recited compounds. As noted correctly by the Examiner, the claims of Group I are directed to a method for inhibiting glucuronidase. In this context, the subject matter of Group II on its face is the activation of a glucuronide prodrug. However, this is true only because glucuronidase is inhibited in all but the recited target tissue, where the glucuronidase that is bound to a target tissue specific substance activates the glucuronide prodrug. Thus, by contrast to the Examiner's allegations, both groups of claims share the same special technical feature, namely the inhibition of glucuronidase by the recited compounds.

For at least these reasons, Applicants respectfully submit that all of the claims should be examined together on the merits. Accordingly, Applicants courteously request the Examiner to reconsider and withdraw the requirement for restriction.

Respectfully submitted,

Date March 11, 2004

By _____

FOLEY & LARDNER LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5414
Facsimile: (202) 672-5399

Richard L. Schwaab
Attorney for Applicant
Registration No. 25,479